

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Ex parte DANIEL A. BARBERG

JUL 16 1998

Appeal No. 96-3407
Application 08/325,549¹

PAT.&T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before MEISTER, FRANKFORT and MCQUADE, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Daniel A. Barberg (the appellant) appeals from the final rejection of claims 1, 16-19, 22, 24, 26, 33, 34, 36 and 37. Claims 3-11, 23, 25, 27-32 and 35, stand withdrawn from further consideration by the examiner under the provisions of 37 CFR § 1.142(b) as being directed to a nonelected species.

¹ Application for patent filed October 18, 1994. According to appellant, this application is a continuation of Application 08/064,945, filed May 20, 1993.

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter a new rejection of claims 1, 16 and 17.

The appellant's invention pertains to a device for storing lengths of elongated flexible material. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Chong	4,015,795	Apr. 5, 1977
Harrill	4,244,536	Jan. 13, 1981

The claims on appeal stand rejected in the following manner:²

Claims 18, 19, 22, 24, 26, 33 and 34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 16 and 17 under 35 U.S.C. § 103 as being unpatentable over Harrill in view of Chong.

² In the final rejection claims 1 and 17 were rejected under the judicially created doctrine of obviousness-type double patenting. In view of the lack of any mention of this rejection in the answer, we presume that the examiner has withdrawn the final rejection of claims 1 and 17 on this ground. *See Ex parte Enm*, 118 USPQ 180, 181 (Bd. App. 1957).

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Claims 18, 19, 22, 24, 26, 33, 34, 36 and 37 under 35 U.S.C. § 103 as being unpatentable over Chong in view of Harrill.

The examiner's rejections are explained on pages 3-6 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 6-29 of the brief and pages 7-9 of the answer.

OPINION

As a preliminary matter we note that the brief contains arguments as to the propriety of the examiner's requirement that the drawings be corrected. Under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and decisions of primary examiners to require corrections to the drawings are not subject to our review. **See Manual of Patent Examining Procedure** (MPEP) §§ 1002.02(c) and 1201 (6th ed., Rev. 3, Jul. 1997); compare *In re Mindick*, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967) and *In re Deters*, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975). Thus, the relief sought by the appellant would have properly been presented by a petition to the Commissioner under 37 CFR § 1.181.

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Considering first the rejection of 18, 19, 22, 24, 26, 33 and 34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention, the answer states that:

A few examples are cited below; **all claims** should be revised carefully to correct other similar deficiencies.

For clarity and definiteness, it appears that -- of-- should be inserted after "exterior" (claims 33, line 1) [.]

The claims reciting the following **functions** lack recitation of sufficient structures/elements and/or necessary structural cooperation between the structures/elements to enable the functions to be effected: "retains the elongate flexible member concentrically ... column" (claim 18, lines 18-20) (it is not clear how the top or bottom plate can perform the recited function), "extends ... through the second access hole" (claim 22, line 3) (it is not clear how the second hole is positioned relative to the cavity).

In claim 18, line 7, "for freely resting" appears to be an incomplete phrase. [Pages 3 and 4.]

We do not agree with the examiner's position. The legal standard for indefiniteness is whether a claim reasonably apprises those of skill in the art of its scope. **In re Warmerdam**, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The examiner, however, has not even alleged that one of ordinary skill in this art would not be reasonably be apprised of

the scope of these claims. Instead, the examiner's position is apparently bottomed on the notion that insufficient structure has been recited to produce the results set forth in recitations of the various functions that the claimed structure is capable of performing.³ Such a criticism, however, goes to the breadth of the claim and it is well settled that breadth alone is not to be equated with indefiniteness. See *In re Johnson*, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); *In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); *In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and *Ex parte Scherberich*, 201 USPQ 397, 398 (Bd. App. 1977). Every structural detail necessary to perform a recited function need not be set forth. Here, we see no reason why one of ordinary skill in this art would not be reasonably apprised of the scope of the claims in question.

As to the examiner's criticism of claim 18 (lines 18-22), we think that it is readily apparent that the top (64) and bottom (42) plates can be considered to help "retain" the elongated flexible member within the longitudinal extent of the column 44

³ There is nothing intrinsically wrong in defining something by what it does rather than what it is. *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981) and *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971).

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as it is being wound thereabout. As to the examiner's criticism of claim 22, the terminology in question is not even functional in character but, instead, describes the **physical location** of the end the elongated flexible member, i.e., that the end of this member "extends through the cavity and through the second access hole." As to the examiner's criticism of claim 18 (line 7), we are of the opinion that the phrase "for freely resting and supporting the spool upon the base" to be relatively clear in defining that the bearing means supports the spool in such a fashion that the spool rests freely on the base. While the examiner is correct in noting that the word "of" should be inserted after "exterior" in line 1 of claim 33, this omission does not obscure the metes and bounds of the claimed subject matter.

In view of the foregoing, we will not sustain the rejection of claims 18, 19, 22, 24, 26, 33 and 34 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of claims 1, 16 and 17 under 35 U.S.C. § 103 as being unpatentable over Harrill in view of Chong, the examiner has taken the position that it would have been obvious to provide the storage device of Harrill with a foot plate in view of the teachings of Chong. However, even if we

were to agree with the examiner that Chong fairly teaches a "foot plate" and that it would have been obvious to provide the device of Harrill with such a plate, the claimed invention would not result. That is, each of the claims requires that the spool be "free from attachment to the container" and that the bottom of the spool be "freely resting" on either the base of the container (claims 1 and 16) or within the container (claim 17). Apparently recognizing this to be the case, the examiner has also taken the position that:

It would also have been obvious to a person having ordinary skill in the art to omit the screw 54 of Harrill so that the spool may be readily removed from the container as it is well established that [the] omission of an element and its function where not needed is obvious [Answer, page 5.]

With respect to the examiner's position that "it is well established" that the omission of an element and its function would have been obvious, we observe that this issue is based upon a determination of obviousness under § 103, rather than upon a "hard and fast" mechanical rule. *See, e.g., In re Wright*, 343 F.2d 761, 769, 145 USPQ 182, 190 (CCPA 1965). Here, in Harrill, the spool 28,30 is both supported by and mounted for rotation on hub 48 which has an integrally formed retaining flange 52. In the assembled state, the hub 48 extends through a

central aperture in the spool and is attached to the container 12 by a bolt 54 which extends entirely through aperture 26 in the rear wall 18 of the container and is fastened to the back side of the rear wall by a nut (see Fig. 2). Thus assembled, the hub serves, not only as the rotatable mounting for the spool, but also as a means to retain the spool in the container (by virtue of the retaining flange 52). If screw 54 were removed as the examiner proposes, it is readily apparent that hub 48 would no longer have the capability of performing the function of rotatably supporting the spool (inasmuch as the hub would no longer be attached to the container) and Harrill's device would no longer operate in the manner intended. Accordingly, we cannot agree that one of ordinary skill in this art would have found it obvious to remove the screw 54 from Harrill's device as the examiner has proposed. This being the case, we will not sustain the rejection of claims 1, 16 and 17 under 35 U.S.C. § 103 as being unpatentable over Harrill in view of Chong.

Considering now the rejection of claims 18, 19, 22, 24, 26, 33, 34, 36 and 37 under 35 U.S.C. § 103 as being unpatentable over Chong in view of Harrill, the answer states that:

It would have been obvious to a person having ordinary skill in the art to alternatively provide the spool of Chong as [sic] the one taught by Harrill to facilitate

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removal/interchanging of the spool of material from the container and so that the inner end of the wound material is accessible such as for use as an extension cord [Page 6.]

We must point out, however, each of the claims under consideration requires that the bottom plate of the spool be freely resting on, but not attached to, the base of the container or bucket. There is nothing in Chong which either teaches or suggests such an arrangement. In Chong, the "spool" is a turntable 26 with a cone 30 formed integrally thereon and is described as being "rotatably mounted **on** and withing pan 16" (column, lines 34 and 35; emphasis ours). As we have noted above with respect to the rejection of claims 1, 16 and 17 under § 103, there is nothing in Harrill which would overcome the deficiencies of Chong. Accordingly, we will not sustain the rejection of claims 18, 19, 22, 22, 24, 26, 33, 34, 36 and 37 under 35 U.S.C. § 103 as being unpatentable over Chong in view of Harrill.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejection.

Claims 1, 16 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which fails to provide support for the subject matter now being

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claimed. We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in *Vas-Cath, Inc. v. Mahurkar* at 935 F.2d 1563-64, 19 USPQ2d 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the **invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

Moreover, as the court in *In re Barker, supra*, set forth 559 F.2d at 593, 194 USPQ at 474, in quoting with approval from *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975): "That a person skilled in the art might realize from reading the

disclosure that such a step is possible is not a sufficient indication to that person that the step is part of appellants' invention" (emphasis in original).

Here, claim 1 (and claim 16 by virtue of its dependency thereon) sets forth (1) that the spool is free from attachment to the container and (2) a footplate "including mounting holes which extend through the foot plate." We must point out, however, that the only originally disclosed embodiments which have mounting holes are those of Figs. 5 and 6, and Fig. 7. In the embodiment of Figs. 5 and 6 the spool is "attached" to the container by retainer 137. In the embodiment of Fig. 7, the spool is attached to the container via electrical cords 11, 170. Thus, there is no descriptive support in the original disclosure for an embodiment which satisfies both the above-noted limitations (1) and (2). Claim 17 sets forth (1) that the spool is free from attachment to the container and (2) a "means for retaining." However, the only originally disclosed "means for retaining" is the member 137 of the embodiment of Figs. 5 and 6, but this member clearly "attaches" the spool to the container. Accordingly, there is no descriptive support for an embodiment which satisfies both limitations (1) and (2) as set forth in claim 17.

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In summary:

The rejection of claims 18, 19, 22, 24, 26, 33 and 34 under 35 U.S.C. § 112, second paragraph, is reversed.

The rejections of claims 1, 16-19, 22, 24, 26, 33, 34, 36 and 37 under 35 U.S.C. § 103 are reversed.

A new rejection of claims 1, 16 and 17 under 35 U.S.C. § 112, first paragraph, has been made.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

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(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.36(a).

REVERSED
37 CFR § 1.196(b)

James M. Meister
JAMES M. MEISTER)
Administrative Patent Judge)

Charles E. Frankfort)
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Administrative Patent Judge) BOARD OF PATENT
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